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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,706	09/27/2001	Rick Rowe	IGT1P130X2/P-676CIP2	7432
79646 7590 05/28/2009 Weaver Austin Villeneuve & Sampson LLP - IGT Attn: IGT P.O. Box 70250 Oakland, CA 94612-0250			EXAMINER MEINECKE DIAZ, SUSANNA M	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 05/28/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/966,706	<b>Applicant(s)</b> ROWE ET AL.	
	<b>Examiner</b> Susanna M. Diaz	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-36 is/are pending in the application.
- 4a) Of the above claim(s) 28-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/25/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This final Office action is responsive to Applicant's reply filed March 25, 2009.

No claims have been amended.

Claims 28-35 remain withdrawn.

Claim 36 stands rejected.

### ***Response to Arguments***

2. Applicant's arguments filed March 25, 2009 have been fully considered but they are not persuasive.

On page 5 of Applicant's arguments, Applicant elects Group I (claim 36) with traverse. However, the restriction was based on an election by original presentation. Applicant has constructively elected which invention to prosecute based on the originally presented and examined invention.

Applicant argues, "Firstly, nothing in section 112 requires explicit disclosure that all claim elements are in the same embodiment." (Pages 5 and 6 of Applicant's arguments) As explained in the rejection under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, the original disclosure describes these species as part of separate embodiments. There is no support in the original disclosure as to how these two species would be integrated into one coherent embodiment; therefore, the combination of these two species into one method (as seen in claim 36) is deemed to present an issue of new matter. Under 35 U.S.C. 112, 1st paragraph, it is Applicant's responsibility to convey in the originally filed disclosure what he/she had possession of. If two separate embodiments are never

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explicitly or implicitly disclosed as envisioned by Applicant as being capable of integration in one cohesive embodiment, then Applicant has not met the burden of describing in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, Applicant cannot in hindsight realize that two separately disclosed embodiments can be utilized jointly and then claim the resulting invention without evidence that Applicant was in possession of such a combination at the time of the invention. In the instant application, Applicant has not presented sufficient evidence to support the assertion that Applicant was in possession of an integrated combination of the embodiments in question at the time of filing of the instant application (or any parent applications).

Applicant states, "Secondly, it is respectfully asserted that one of skill in the art would readily understand the specification and claims 28-36 and would be able to interpret and practice the invention." (Pages 5 and 6 of Applicant's arguments) While this may be true, it is not germane to the current rejection under 35 U.S.C. 112, 1st paragraph. This statement is more relevant to a lack of enablement rejection; however, claim 36 is instead rejected for presenting new matter. What may or may not be obvious is not the test (*Lockwood vs. Anderson*, 41USPQ 2d @ 1966). Applicant has the burden of showing that a person of skill in the art would have understood, at the time the patent application was filed, that the description requires the limitation. (*Hyatt v. Boone*, 146 F.3d 1348, 1354, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998))

Applicant further submits, "To the extent any additional search burden is created, the filing of the Request for Continued Examination on October 7, 2008 is submitted to address this issue." (Pages 5 and 6 of Applicant's arguments) The Examiner points out that MPEP § 818.02(a) states, "The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application, and in any request for continued examination (RCE) which has been filed for the application. Subsequently presented claims to an invention other than that acted upon should be treated as provided in MPEP § 821.03." Therefore, the submission of an RCE does not afford Applicant the right to switch inventions.

On page 7 of Applicant's arguments, Applicant submits that "the specification clearly indicates that these recitations may be used in the same system or method" and then Applicant cites ¶ 200 from the specification. ¶ 200 effectively states that not only may the system track player losses, but it may also track winnings. Nevertheless, there is no integration of these capabilities. Applicant has the burden of showing possession of a single, coherent invention. The Examiner does not dispute that Applicant's overall system is capable of tracking losses and winnings; however, claim 36 attempts to merge one embodiment for tracking losses with another for tracking winnings and the original disclosure does not provide a cohesive manner for integrating both embodiments. As disclosed in the specification, the manner of tracking the losses and acting accordingly is separately patentable and mutually exclusive in relation to the manner of tracking the winnings and acting accordingly. Claim 36 simultaneously monitors both losses and winnings to determine if the player should be prevented from

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further play; however, the original disclosure does not explicitly or implicitly convey this simultaneous monitoring.

Applicant has not presented evidence showing that these two species were envisioned as usable in the same embodiment at the time of filing; therefore, Applicant's traversal is not persuasive and the restriction requirement is hereby made FINAL.

Applicant argues that neither Crevelt, Johnson, nor Walker addresses "including a threshold win amount limit, above which subsequent play should be limited." (Page 7 of Applicant's arguments) Walker allows players to set a limit on winnings such that automated play is stopped if the winnings threshold is exceeded (Fig. 8B, col. 8, lines 15-33, 50-61 -- "A limiting criterion, on the other hand, is any information that may define the beginning or end of an automated play session. In the present embodiment, limiting criteria include: ...total losses, total winnings...Similarly, the player may define a specific winning credit value as a limiting criteria of play, e.g. stop playing if a credit of one thousand dollars is ever registered"). This is indicative of "a threshold win amount limit, above which subsequent play should be limited."

Applicant then argues that Walker teaches away from limiting play since Walker also encourages maximizing play. According to Walker, "there is provided a method and apparatus for automated play which permits a casino to recognize substantially increased play time, and hence revenue, from a gaming device. At the same time, the invention satisfies a player's emotional desire to maximize his playing time on selected gaming devices, while accommodating the physical need to at times be away from the machines." (Col. 2, lines 29-37) Both Crevelt and Walker are directed toward gambling

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environments; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Crevelt to perform the step of storing a threshold win amount limit, above which subsequent play should be limited and the step of comparing the amount won to the limit on the amount won, as taught by Walker, in order to create an automated play environment "which permits a casino to recognize substantially increased play time, and hence revenue, from a gaming device [and at] the same time satisfy a player's emotional desire to maximize his playing time on selected gaming devices, while accommodating the physical need to at times be away from the machines" (as suggested in col. 2, lines 29-37 of Walker). Walker suggests a balance of features that can be customized to both the casino's as well as the player's preferences. For example, within thresholds set by the player, the casino would want to maximize revenue. Otherwise, a casino could encourage a player to spend beyond his/her means, but that might prevent the player from returning to the casino on another occasion. Maximizing the casino's revenue does not necessarily mean that the player spends as much as possible (regardless of whether the player can afford to spend that much), but it could also mean that the casino maximizes its revenue within certain reasonable expectations. Consequently, the Examiner submits that Walker's ability to place limits on both losses and winnings (as explicitly taught in col. 8 of Walker) does not teach away from the claimed invention. Walker merely recognizes the benefits of being able to handle multiple conditions and thresholds.

Applicant's arguments are not persuasive and the rejections are maintained.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 36 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Non-elected claims 28-35 recite the details of preventing a player from continuing to play when a winnings limit has been exceeded (i.e., Species II). Original claims 1-27 (now cancelled) and new claim 36 recite details of preventing a player from continuing to play when a loss limit has been exceeded (i.e., Species I). Claim 36 also recites the details of preventing a player from continuing to play when a winnings limit has been exceeded (i.e., Species II). The original disclosure describes these species as part of separate embodiments. There is no support in the original disclosure as to how these two species would be integrated into one coherent embodiment; therefore, the combination of these two species into one method (as seen in claim 36) is deemed to present an issue of new matter.

Appropriate correction is required.



***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crevelt et al. (U.S. Patent No. 5,902,983) in view of Johnson (US 2001/0031663 A1) and further in view of Walker et al. (U.S. Patent No. 6,012,983).

Crevelt discloses a method of monitoring player financial activities in a gaming environment in which a player may play one or more games comprising the steps of:

[Claim 36] generating a financial account corresponding to a player, said account represented by at least one data file, said at least one data file adapted to contain financial information (col. 5, lines 36-40 -- Each gaming machine may provide player tracking information and accounting information to the local area network; col. 5, lines 45-52; col. 6, lines 3-9; col. 8, lines 18-61; col. 9, lines 58-65; col. 10, line 55 through col. 11, line 9);

storing financial information regarding monetary amounts belonging to a player which may be used to play said one or more games (col. 5, lines 36-40 -- Each gaming machine may provide player tracking information and accounting information to the local

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area network; col. 5, lines 45-52; col. 6, lines 3-9; col. 8, lines 18-61; col. 9, lines 58-65; col. 10, line 55 through col. 11, line 9);

automatically creating a data file for the player at a financial transaction host if there is no data file associated with the player, wherein the data file is matched with the player using a unique identifier associated with a remote financial institution (col. 8, lines 42-67; col. 9, lines 1-29 – The player's financial account information is electronically accessed. When the player set up his/her account, a processing device must have automatically, i.e., through use of a machine/computer/processor, created a data file for the player since the player previously did not have his/her own data file for that account; Figs. 1, 2; col. 5, lines 17-45; col. 8, lines 42-61 -- Each gaming machine may provide player tracking information and accounting information to an EFT system through a local area network. The EFT system, i.e., the financial transaction host, maintains player-related data; columns 9-10 – The casino may communicate with an external financial institution to conduct transactions with an account associated with the player. Such an external account identifier would be a unique identifier associated with an outside institution. Funds may be transferred between the player's internal casino account and outside financial institution account);

storing financial information regarding monetary amounts expended by a player in playing said one or more games (col. 5, lines 36-40 -- Each gaming machine may provide player tracking information and accounting information to the local area network; col. 5, lines 45-52; col. 6, lines 3-9; col. 8, lines 18-61; col. 9, lines 58-65; col. 10, line 55 through col. 11, line 9); and

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determining player loss from said financial information (col. 3, lines 8-18);

determining an amount won from said financial information (col. 3, lines 8-18).

Regarding claim 36, Crevelt does not expressly teach the step of preventing said player from utilizing monetary amounts associated with said account to play said one or more games for at least a period of time if said determined player loss meets certain criteria. However, Johnson discloses the step of preventing said player from utilizing monetary amounts associated with said account to play said one or more games for at least a period of time if said determined player loss meets certain criteria (¶¶ 13, 17, 19, 23). This feature of Johnson helps to curb gambling problems as well as assist casinos (and other gambling/playing locations) in conforming to jurisdictional restrictions regarding gambling loss limits (¶¶ 10, 13, 17). Crevelt too is concerned with reasonably limiting the money spent by a player on gambling/gaming machines (col. 2, lines 18-28; 31-49; col. 4, lines 54-62), as evidenced by Crevelt's statements that the prior art "likely will be unpalatable to at least some legislatures which regulate gaming" and that Crevelt addresses "a need for an EFT system that allows cashless transfers of funds to gaming machines and yet protects against rash decisions by some players to divert large amounts of their savings to gaming" (col. 2, lines 23-28). Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Crevelt to perform the step of preventing said player from utilizing monetary amounts associated with said account to play said one or more games for at least a period of time if said determined player loss meets certain criteria in

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order to help curb gambling problems as well as assist casinos (and other gambling/playing locations) in conforming to jurisdictional restrictions regarding gambling loss limits (as suggested in both ¶¶ 10, 13, and 17 of Johnson and col. 2, lines 23-28 of Crevelt).

Crevelt does not explicitly disclose the step of storing a threshold win amount limit, above which subsequent play should be limited or the step of comparing the amount won to the limit on the amount won. However, Walker allows players to set a limit on winnings such that automated play is stopped if the winnings threshold is exceeded (Fig. 8B, col. 8, lines 15-33, 50-61). According to Walker, "there is provided a method and apparatus for automated play which permits a casino to recognize substantially increased play time, and hence revenue, from a gaming device. At the same time, the invention satisfies a player's emotional desire to maximize his playing time on selected gaming devices, while accommodating the physical need to at times be away from the machines." (Col. 2, lines 29-37) Both Crevelt and Walker are directed toward gambling environments; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Crevelt to perform the step of storing a threshold win amount limit, above which subsequent play should be limited and the step of comparing the amount won to the limit on the amount won, as taught by Walker, in order to create an automated play environment "which permits a casino to recognize substantially increased play time, and hence revenue, from a gaming device [and at] the same time satisfy a player's emotional desire to maximize his playing time on selected gaming devices, while

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accommodating the physical need to at times be away from the machines” (as suggested in col. 2, lines 29-37 of Walker).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/  
Primary Examiner, Art Unit 3692